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| BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030 | | | BOTTs, MICHAEL K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2176 | |

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/816,049 | BARRUS, JOHN W. |
| | Examiner | Art Unit |
| | Michael K. Botts | 2176 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 September 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-77 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-77 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application
6) Other: _____

DETAILED ACTION

1. This is a Final Office Action on the merits. This action is responsive to the following communication: Amendment and Response to Office Action, which was filed on September 14, 2006.
2. Claims 1-77 are currently pending in the case, with claims 1, 33, 34, and 61 being the independent claims.
3. The specification was appropriately amended to reflect the patent application number of the parent application and the identification and status of commonly owned and related applications. Accordingly, the objection to the specification on these grounds is withdrawn.
4. The filing of a proper terminal disclaimer for copending patent application number 10/665/097, was filed on September 14, 2006. Accordingly, the double patenting rejection is withdrawn.
5. Claims 1-77 are rejected.

The Specification

6. Applicant is reminded of the continuing requirement to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification, when appropriate, and the status of all citations of U.S. filed applications in the specification should also be updated, when appropriate.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 8, 9, 11-32, 34, 40-66, 68-71, and 73-77 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Johnson, et al. (U.S. Patent 5,267,303, issued November 30, 1993) [hereinafter “Johnson”].

Regarding **independent claim 1, as amended**, Johnson teaches:

*A computer-implemented method comprising:
receiving an image of an overview of a collection that comprises a first plurality of check boxes associated with documents and a second plurality of check boxes associated with actions;
identifying at least one action set forth in the image;
identifying at least one document, wherein the identifying the at least one action based on the second plurality of check boxes and the identifying the at least one document based on the first plurality of check boxes is performed using a single image; and
performing the at least one action on the at least one document.*

(It is noted that the term “collection,” and the related term “sub-collection,” are not

specially defined in the application. From the specification and claims, the Examiner believes the terms to have been intended by the applicants to be used in their usual and ordinary meaning, such as: "a group of objects or works to be seen or kept together." "The American Heritage College dictionary," definition 2 of "collection," Houghton Mifflin Company, Fourth Edition, 2002. As used in the context of a computer or computer stored documents, the term "collection" is believed by the Examiner to be the same as a file. See, "Microsoft Computer Dictionary," Fifth Edition, Microsoft Press, 2002, definition of "file" as follows, in relevant part: "A complete named collection of information, such as a program, a set of data used by a program, or a user-created document." Accordingly, as used in this application, the limitation term "collection," including a "sub-collection," will be read consistent with the definition of a computer "file" for the remainder of this Office Action.

Johnson teaches the use of a coversheet ("image of an overview of a collection") to access documents that are stored on a computer, and processing the documents as indicated. See, Johnson, figure 8, and col. 1, line 38 through col. 2, line 57, and col. 18, line through col. 23, line 51, teaching manipulation of a collection through a plurality of check boxes indicating documents and a plurality of check boxes associated with actions.)

Regarding dependent claim 2:

Claim 2 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

Regarding dependent claim 3:

Claim 3 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

Regarding dependent claim 4:

See, Johnson, col. 19, lines 26-31, teaching graphical content in the form of an image, for use in identifying a document. The Examiner takes official notice of the fact that "thumbnail" images were a well known and widely used icons representing software applications and functions and it would have been obvious to one of ordinary skill in the art at the time of the invention to use a thumbnail representation of a document on a document image index coversheet for purposes of giving visual cues to the user as to the content of the documents represented. See, Bloomberg (U.S. Patent 5,761,686, issued June 2, 1998), col. 3, lines 7-31, teaching that the use of thumbnail images as icons representing documents in applications and functions was well known in the art at the time of the invention.

Regarding dependent claim 6:

Claim 6 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

Regarding dependent claim 7:

See, Johnson, col. 19, lines 26-31, teaching graphical content in the form of an image, for use in identifying a document.

Regarding dependent claim 8:

See, Johnson, col. 1, lines 18-23, teaching the use of a bar code as a machine readable pointer.

Regarding dependent claim 9:

See, Johnson, col. 1, lines 18-23, teaching the use of a bar code as a machine readable pointer.

Regarding dependent claim 11:

See, Johnson, col. 19, lines 26-31, teaching graphical content in the form of an image, for use in identifying a document.

Regarding dependent claim 12:

The rejection of claim 2 is incorporated herein by reference. See also, Johnson, figures 7-9, teaching retrieving (printing), faxing, and deleting.

Regarding dependent claim 13:

See, Johnson, figure 8, teaching identifying a mark in a particular location in order to indicate an action.

Regarding dependent claim 14:

See, Johnson, col. 18, lines 55-63, teaching selection of all documents or a set of documents.

Regarding dependent claim 15:

See, Johnson, figure 8, and col. 18, lines 55-63, teaching the coversheet as an overview of a collection of documents.

Regarding dependent claim 16:

See, Johnson, col. 19, lines 26-31, teaching graphical content in the form of an image, for use in identifying a document. The Examiner takes official notice of the fact that "thumbnail" images were a well known and widely used icons representing software applications and functions and it would have been obvious to one of ordinary skill in the art at the time of the invention to use a thumbnail representation of a document on a document image index coversheet for purposes of giving visual cues to the user as to the content of the documents represented. See, Bloomberg (U.S. Patent 5,761,686, issued June 2, 1998), col. 3, lines 7-31, teaching that the use of thumbnail images as icons representing documents in applications and functions was well known in the art at

the time of the invention.

Regarding dependent claim 17:

See, Johnson, col. 14, lines 16-30, teaching the store action which may be used to create a machine readable identifier on the form indicating the location of a document.

Regarding dependent claim 18:

See, Johnson, col. 18, lines 64-68, teaching creation of a list of documents as a document index.

Regarding dependent claim 19:

See, Johnson, col. 19, lines 26-31, teaching graphical content in the form of an image, for use in identifying a document. The Examiner takes official notice of the fact that "thumbnail" images were a well known and widely used icons representing software applications and functions and it would have been obvious to one of ordinary skill in the art at the time of the invention to use a thumbnail representation of a document on a document image index coversheet for purposes of giving visual cues to the user as to the content of the documents represented. See, Bloomberg (U.S. Patent 5,761,686, issued June 2, 1998), col. 3, lines 7-31, teaching that the use of thumbnail images as icons representing documents in applications and functions was well known in the art at the time of the invention.

Regarding dependent claim 20:

See, Johnson, col. 19, lines 26-31, teaching graphical content in the form of an image, for use in identifying a document, each graphic being an icon.

Regarding dependent claim 21:

See, Johnson, figures 7-9, teaching grouping of documents and actions relating to groups, noting that marking any of the several documents listed would create a group.

Regarding dependent claim 22:

See, Johnson, figures 7-9, teaching grouping of documents and actions relating to groups, noting that marking any of the several documents listed would create a sub-collection of the entire list.

Regarding dependent claim 23:

See, Johnson, figures 8, elements 590 and 594, teaching transmitting a document to a determined destination.

Regarding dependent claim 24:

See, Johnson, figures 8, elements 590 and 594, teaching transmitting a document to a user input determined destination.

Regarding dependent claim 25:

See, Johnson, figure 11, elements 262 and 264, teaching transmitting a document to a determined destination group of recipients.

Regarding dependent claim 26:

See, Johnson, figure 11, elements 262 and 264, teaching an action indication area of the image, being the identified check boxes.

Regarding dependent claim 27:

See, Johnson, figures 8, element 594, for indicating a recipients fax number, and see , figure 11, elements 262 and 264, teaching an action indication area of the image, being the identified check boxes.

Regarding dependent claim 28:

See, Johnson, col. 22, lines 29-39, teaching that the document may be sent via e-mail.

Regarding dependent claim 29:

See, Johnson, col. 22, lines 29-39, teaching that the document may be sent via fax.

Regarding dependent claim 31:

See, Johnson, col. 20, lines 22-31, teaching that a document at a location may be saved and transmitted to a recipient at a later time.

Regarding dependent claim 32:

See, Johnson, col. 20, lines 22-31, teaching that a document at a location may be saved and transmitted to a recipient at a later time.

Regarding Independent claim 33, as amended:

A computer-implemented method comprising:
receiving a document index image of an overview of a collection and a machine readable pointer identifying the collection;
locating, on the document index image, at least two marked check boxes, wherein a first check box is associated with a document and a second check box is associated with an action;
identifying the document for the first marked check box based on location of the first marked check box on the document index image;
identifying an action from the document index image for the second marked check box; and
performing the action on the documents identified for each of the marked check boxes.

(Claim 33 incorporates substantially similar subject matter as claimed in claim 2 and is

rejected along the same rationale.)

Regarding independent claim 34, as amended:

An article of manufacture comprising one or more recordable media having instructions stored thereon which, when executed by a computer, cause the computer to perform a method comprising:

receiving an image of an overview of a collection that comprises a first plurality of check boxes associated with documents and a second plurality of check boxes associated with actions;

identifying at least one action set forth in the image;

identifying at least one document, wherein the identifying the at least one action based on the second plurality of check boxes and the identifying the at least one document based on the first plurality of check boxes is performed using a single image; and

performing the at least one action on the at least one document.

(Claim 34 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding dependent claims 35-38:

Claims 35-38 incorporate substantially similar subject matter as claimed in claims 2, 3, 6, and 7, respectively, and are rejected along the same rationale.

Regarding dependent claims 40-44:

Claims 40-44 incorporate substantially similar subject matter as claimed in claims 11-15, respectively, and are rejected along the same rationale.

Regarding dependent claims 45-50:

Claims 45-50 incorporate substantially similar subject matter as claimed in claims 15-20, respectively, and are rejected along the same rationale.

Regarding dependent claims 51-60:

Claims 51-60 incorporate substantially similar subject matter as claimed in claims 23-32, respectively, and are rejected along the same rationale.

Regarding independent claim 61, Johnson teaches:

*A system for processing a stored document, comprising:
a document index input device, to receive an image of a document index;
a marked check box locator, coupled to the document input index device,
to identify at least one action set forth in the image and to identify a location on
the document index image of at least one indication area having a mark therein,
the at least one indication area being associated with at least one document;
a document identifier, coupled to the marked check box locator, to identify
the at least one document based on the location of the at least one indication
area having the mark therein; and*

a document processor, coupled to the document identifier, to perform the at least one action on the at least one document.

(Claim 61 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding dependent claims 62-66:

Claims 62-66 incorporate substantially similar subject matter as claimed in claims 6, 7, 11, 13, and 14, respectively, and are rejected along the same rationale.

Regarding dependent claim 67:

Claim 67 incorporates substantially similar subject matter as claimed in claim 3, and is rejected along the same rationale.

Regarding dependent claims 68-71:

Claims 68-71 incorporate substantially similar subject matter as claimed in claims 15, 15, 16, and 17, respectively, and are rejected along the same rationale.

Regarding dependent claim 72:

Claim 72 incorporates substantially similar subject matter as claimed in claims 5, and is rejected along the same rationale.

Regarding dependent claims 73-77:

Claims 73-77 incorporate substantially similar subject matter as claimed in claims 18, 16, 23, and 28, respectively, and are rejected along the same rationale.

8. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 10 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over J Johnson, et al. (U.S. Patent 5,267,303, issued November 30, 1993) [hereinafter “Johnson”] as applied to claim 1 above, and further in view of Petteruti, et al. (U.S. Patent 6,409, 401, filed March 26, 2001) [hereinafter “Petteruti”].**

Regarding dependent claim 10:

Johnson teaches the limitations of claim 1, but does not expressly teach the use of an RFID tag identifying the collection.

Petteruti teaches a Radio Frequency Identification, RFID, tag to be attached as a label to be attached to media printed by a printer, with such RFID tag identifying the object. See, Petteruti, col. 1, lines 47-55.

Johnson and Petteruti are combinable in that they involve the same art of printing labels to identify information.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Johnson and Petteruti to create a label with an RFID tag attached to a document index for the obvious and advantageous purpose of rapid and easy identification of a document through a label or tag.

The suggestion or motivation for doing so is found in Johnson, which allows for variance from the stated embodiments being consistent with the invention, and from the fact that an RFID label is merely a different type of label which was known in the art at the time of the invention by one of ordinary skill.

Therefore, it would have been obvious to combine the coversheet and label invention of Johnson with the printing of RFID tag labels in Petteruti to result in the invention specified in claim 10.

Regarding dependent claim 39:

Claim 39 incorporates substantially similar subject matter as claimed in claim 10 and is rejected along the same rationale.

10. Claims 5 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, et al. (U.S. Patent 5,267,303, issued November 30, 1993) [hereinafter “Johnson”] in view of Cooper, et al. (U.S. Patent 5,680,223, issued October 21, 1997) [hereinafter “Cooper”].

Regarding dependent claim 5:

Johnson teaches the invention of claim 1, but does not expressly teach the location of an indication area.

See, Cooper, col. 10, lines 46-60, teaching an x-y coordinate to locate position of a label.

Johnson and Cooper are combinable in that they involve the same art of document management by cover sheets. In addition, both Johnson and Cooper are named inventors in each of the references and the patents are both assigned to the same Assignee.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Johnson and Cooper.

The suggestion or motivation for the combination is that the location function is but an additional functionality to very similar document management inventions with

similar inventors on the two patents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Johnson and Cooper to result in the claim specified in claim 30.

Regarding dependent claim 30:

Johnson teaches the invention of claim 1, but does not expressly teach the use of optical character recognition (OCR).

See, Cooper, col. 1, line 8 through col. 18, line 65, specifically, col. 4, lines 23-38, teaching OCR.

Johnson and Cooper are combinable in that they involve the same art of document management by cover sheets. In addition, both Johnson and Cooper are named inventors in each of the references and the patents are both assigned to the same Assignee.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Johnson and Cooper.

The suggestion or motivation for the combination is that the OCR is but an additional functionality to very similar document management inventions with similar inventors on the two patents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Johnson and Cooper to result in the claim specified in claim 30.

11. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Response to Arguments

Applicants' arguments filed September 14, 2006 have been fully considered, but they are not persuasive.

Regarding rejections of claims 1, 8, 9, 11-32, 34, 40-60, 61-6, 68-71, and 73-77, under 35 U.S.C. 102(b):

Applicant argues that the reference, Cooper, fails to show the newly amended feature of "receiving an image of an overview of a collection that comprises a first plurality of check boxes associated with documents and a second plurality of check boxes associated with actions and identifying an action based on the one plurality of check boxes and identifying a document based on another plurality of check boxes using a single image." Applicant argues further that "Cooper does not teach, mention, nor disclose identifying at least one action based on the one plurality of check boxes and identifying at least one document based on another plurality of check boxes using a single image." See, Amendment, pages 18-20.

The Examiner disagrees.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Specifically, it is noted that a plurality of check boxes identifying a document and a plurality of check boxes associated with actions is expressly taught in Johnson. See, Johnson, figure 8, and col. 1, line 38 through col. 2, line 57, and col. 18, line through col. 23, line 51, as cited in the rejections above.

Regarding rejections of claims 2-7, 10, 33, 35-39, 67, and 72, under 35 U.S.C. 103(a):

Applicant argues that the references, Cooper and Cotte, do not teach or suggest a combination of the references. See, Amendment, pages 20-21.

The Examiner disagrees.

The Examiner reads this argument to state a lack of suggestion or motivation to combine the references.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Specifically, the reference, Cooper, has been replaced with the reference, Johnson. The suggestion or motivation for combining the references is that both Cooper and Johnson are inventors on each others patents, and both patents are assigned to the same Assignee.

Regarding rejections of claims 2-7, 10, 33, 35-39, 67, and 72, under 35 U.S.C. 103(a):

Applicant argues that combination of the references, Cooper and Cotte, does not anticipate the claims, specifically arguing that the reference, Cooper, "does not disclose identifying at least one action based on the one plurality of check boxes and identifying at least one document based on another plurality of check boxes using a single image." See, Amendment, pages 21-22.

The Examiner disagrees.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Specifically, it is noted that a plurality of check boxes identifying a document and a plurality of check boxes associated with actions is expressly taught in Johnson. See, Johnson, figure 8, and col. 1, line 38 through col. 2, line 57, and col. 18, line through col. 23, line 51, as cited in the rejections above.

Additional Prior Art

12. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Cooper, et al. (U.S. Patent 5,448,375) teaching multiple check boxes on a single image for purposes of selecting documents and actions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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